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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,889	05/14/2001	Josh Hogan	10960373-7	2152

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

ZAND, KAMBIZ

ART UNIT PAPER NUMBER

2132

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,889

Applicant(s)

HOGAN, JOSH

Examiner

Kambiz Zand

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
3. New claims 3 and 4 have been added.
4. Claims 1-4 are pending.

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Specification

6. The disclosure is objected to because of the following informalities: Please update the information with respect to application number 09/134,145 on page 1 of the specification. The records show the above application has been patented. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claims 1-4** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter "pattern of merge bits" or "merge bits", "selecting merge bits" has no support in the specification. Corrections or clarification are requested.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. **Claims 1-4** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the phrase "transmitting decryption data" and "decryption data" are confusing and unclear. It is not clear if the decryption data is same as clear text that has never been encoded or encrypted or it is decryption of encoded/encrypted data, in this case then the steps for decryption data is missing from the claim language.

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This cause confusion because in steps a of the claim, one wonders if the bit being encoded is the bit of a data never went through encoding before or it is a repeat steps or re-encryption of decoded bit of the decoded data.

It is further confusing because the preamble of the claim disclose "transmitting decryption data", however the step (c) transmit the encoded data and not the decryption data.

Examiner considers "decryption data" corresponds to clear data for the purpose of examination.

Corrections or clarifications are requested.

In claims 1-4, the "pattern of merge bits", "decoding the pattern of merge bits", "fixed-length bit patterns", "selecting merge bits" phrases respectively makes the claims indefinite and unclear in that neither method/ or means nor interrelationship of method/ or means are set forth in these claims in order to achieve the desired results expressed in the above phrases.

Examiner considers "merge bits " as bits that are inserted into a block of data bits; and the selection as selecting such bits for the purpose of examination.

Corrections or clarifications are requested.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. the claimed invention lacks patentable utility. **Claim 4** only describes a selection.

Other limitations in the claims are only defining/ or describing such a selection.

No hardware element is present in the limitation of the claims on which such a selection could be reside/stored or operate.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. **Claims 1, 3 and 4** are rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1 of U.S.

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Patent Number 5,699,434. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim(s) 1, 3 and 4 of U.S. Patent Number 5,699,434 contain(s) every element of claim(s) 1, 3 and 4 of the instant application and as such anticipate(s) claim(s) 1, 3 and 4 of the instant application..

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 4 of U.S. Patent

Number 6,278,386. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim(s) 1, 2 and 4 of U.S. Patent Number 6,278,386 contain(s) every element of claim(s) 1-4 of the instant application and as such anticipate(s) claim(s) 1-4 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " **ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent Number 5,828,754. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim(s) 1 of U.S. Patent Number 5,828,754 contain(s) every element of claim(s) 1-4 of the instant application and as such anticipate(s) claim(s) 1-4 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

17. **Claims 1-4** are rejected under 35 U.S.C. 103(a) as being obvious over Sako (EP 0 347 934 B1).

As per claim 1 Sako teach a method of transmitting decryption data, the method comprising the following steps:

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- a) encoding a bit of decryption data into a pattern of merge bits (please see fig.3; page 3, lines 43-56; page 4, lines 1-54 and page 5 where the encoding is the insertion of bits "100" or "010" or "100" and the patterns is from "100 or 010 or 001 and back to 100");
 - b) encoding channel bits having the pattern of merge bits of step (a) (see data being encoded on the above pages that represent channel bits) ; and
 - (c) transmitting the channel bits resulting from step (b) (see page 5, lines 49-56).
- It would have been obvious to one of ordinary skilled in the art at the time the invention was made to select data signal to represent channel bits because the data signal consist of data content that are encoded according to a pattern of merge bits. Also see the entire reference for detail.

As per claim 2 Sako teach the method of claim 1, further comprising using the decryption data for inhibiting copy of digital information. the method comprising the following additional steps:

- (d) decoding the channel bits from step (c);
 - (e) decoding the pattern of merge bits in the channel bits of step (d) back into the bits of step (a) see ; and
 - (f) using the decoded bit of step (e) to modify the decoded channel bits of step (d).
- see page 4 and 5 in relation with page 8; page 9, lines 1-35 for reproduction/decoding procedures of the encoded bits).

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As per claim 3 Sako teach a digital medium, comprising:

first data encoded into fixed-length bit patterns (see page 4 and 5);

merge bits between the fixed-length bit patterns of first data, the merge bits selected to satisfy run-length-limited requirements and digital-sum-variance- requirements (see page 4-5; and

at least some merge bits also selected to specify second data (see page 5, lines 53-58).

It would have been obvious to one of ordinary skilled in the art at the time the invention was made to select data signal to represent channel bits because the data signal consist of data content that are encoded according to a pattern of merge bits.

Also see the entire reference for detail.

As per claim 4 Sako teach method comprising:

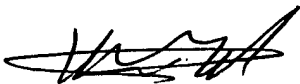
selecting merge bits to satisfy run-length-limited requirements, digital-sum-variance requirements, and also to specify at least one bit of data (see page 5, lines 55-58; page 6).

It would have been obvious to one of ordinary skilled in the art at the time the invention was made to select data signal to represent channel bits because the data signal consist of data content that are encoded according to a pattern of merge bits.

Also see the entire reference for detail.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kambiz Zand

05/18/2005